

**REMARKS**

Applicant appreciates the Examiner's review of the above-identified application and respectfully requests reconsideration and allowance in view of the above amendments and following remarks.

Claims 1-6, 8-10, 13 and 14 are pending. Claims 1, 3-6, 8-10, 13 and 14 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Bateman et al. (U.S. Patent No. 5,884,032) in view of Grossman et al (U.S. Patent No. 5,536,965), Srinivasan (U.S. Patent No. 5,185,782), and Sutton (U.S. Patent 4,143,243). Claim 2 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Bateman et al. in view of Grossman et al, Srinivasan and Sutton as applied to claim 1, and further in view Szlam et al. (U.S. Patent No. 5,828,731). Claims 1 and 10 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Dezonno et al. (U.S. Patent No. 5,991,394) in view of Srinivasan and Sutton. Applicant respectfully traverses these rejections.

Applicant respectfully submits that none of the cited references disclose or suggest how to best connect a telephone call to an inquiring party via a telephone line when the inquiring party has requested the call by accessing a computer network via

the same telephone line as recited in amended independent claims 1 and 10. As discussed previously in the February 26, 2002 Preliminary Response, when using a computer equipped with a dial-up modem, an inquiring party might visit a company website on the World Wide Web ("World-Wide-Web") and request a company representative to contact him. However, since the inquiring party is currently using the telephone line to access the WWW, it is unavailable for the representative's return call (i.e., the line is busy).

The present invention recognizes that the best time to respond to the inquiring party's request is immediately thereafter, and that the inquiring party's telephone line will be busy until he has ended his modem's connection to the network over the telephone line. Accordingly, the systems and methods recited in amended independent claims 1 and 10 determine that the inquiring party is proximate the origin point of the telephone line and utilizing the telephone line by recognizing that the inquiring party has requested a call back and that an immediate call back has resulted in a busy signal. Based on these three criterion (i.e., the call back request, immediate call back, and busy signal), the systems and methods recited in independent

claims 1 and 10 immediately redial the inquiring party's telephone number each time a busy signal is detected so as to contact the inquiring party as soon as he has ended his modem's connection to the network via the telephone line. Applicant respectfully submits that none of the cited references disclose or suggest this feature because none of the references attempt to solve the same problem.

Bateman et al. concern a system for allowing a call center agent and a customer to simultaneously talk on the telephone and view information available on a computer network over a telephone line and separate second network connection. Because the agent in the Bateman et al. system calls the customer back on a separate line than the line that the user uses to access information on the computer network, Bateman et al. suggest nothing about how to best call back an inquiring party on the same line that the inquiring party used to access information on the computer network. As noted by the Examiner, Bateman et al. do not even disclose or suggest redialing a busy number. Accordingly, Bateman et al. do not disclose or suggest using the three criterion discussed above to determine that the inquiring party is proximate the telephone and utilizing the telephone line as recited in amended independent

claims 1 and 10. Additionally, there is no motivation to combine Bateman et al. with other references because Bateman et al. are not concerned with the same problem as the present invention.

Grossman et al. concern methods and systems for optimizing telephone contact. Grossman et al. have nothing to do with how or when is the best time or way to contact an inquiring party who has requested a callback by accessing a computer network over a telephone line. As noted by the examiner, Grossman et al. do not even disclose or suggest redialing a busy number. Accordingly, Grossman et al. do not disclose or suggest using the three criterion discussed above to determine that the inquiring party is proximate the telephone and utilizing the telephone line as recited in amended independent claims 1 and 10. Moreover, there is no motivation to combine Grossman et al. with other references because Grossman et al. is not concerned with the same problem as the present invention.

Srinivasan concerns an automatic callback arrangement for automatically returning a call at a time specified by the original caller, possibly using the same line that the user used to trigger the callback. The systems and methods of Srinivasan, however, only concern connecting calls to parties who have requested

callbacks by using the telephone. Srinivasan contains no teaching about how to connect a call to a party who has requested a callback while using a telephone line to connect to a computer network.

The difference is significant because the problems raised by each scenario are completely different. The user who requests a callback by telephone (as described by Srinivasan) would most likely hang-up the phone immediately after requesting the callback thereby making the line immediately available. By contrast, an inquiring party using a computer connected to a network is very likely to continue using the line to access additional information on the network after requesting a callback. Accordingly, Srinivasan does not disclose or suggest using the three criterion discussed above to determine that the inquiring party is proximate the telephone and utilizing the telephone line as recited in amended independent claims 1 and 10. There is no motivation to combine Srinivasan with other references because Srinivasan is concerned with only connecting calls to parties who have requested callbacks by using the telephone at a specified time. In fact, Srinivasan teaches away from the present invention.

Sutton concerns a telephone set that automatically redials a

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telephone number after a busy signal has been received. The telephone set includes a control circuit, responsive to both the detection of a busy signal and the releasing of the telephone line, which waits a predetermined fixed amount of time subsequent to which it seizes the line and causes the number stored to be redialed. In contrast to amended independent claims 1 and 10, Sutton does not receive a call back request. This is because Sutton discloses placing only outbound calls.

Sutton does not have anything to do with how or when is the best time or way to contact an inquiring party who has requested a callback by accessing a computer network over a telephone line. Accordingly, Sutton does not disclose or suggest using the three criterion discussed above to determine that the inquiring party is proximate the telephone and utilizing the telephone line as recited in amended independent claims 1 and 10. Additionally, there is no motivation to combine Sutton with other references because Sutton is only concerned with placing outbound calls and has nothing to do with receiving call back requests.

Sutton is also not analogous art. As discussed above, Sutton is not concerned with, let alone reasonably pertinent to, the particular problem with which the present invention is concerned.

Applicant submits that one looking to solve the problem of receiving call-back requests in a call center would not look to solve the problem by looking at telephone sets which are capable of only making outbound calls.

Additionally, Applicant respectfully submits that Sutton is not in Applicant's field of endeavor. As discussed above, Sutton is concerned with telephone sets for making outbound calls only, whereas the present invention is concerned with receiving call back requests in a call center. While both use telephony in a general sense, these are two very distinct areas. Applicant submits that it is improper to simply lump them together as "telephony" in general.

Dezonno et al. concern a system for scheduling and completing call back requested by an inquiring party. Notably, however, Dezonno et al. teach a system that requires the user to specify a preferred call back time. As a result, Dezonno et al. show neither a recognition of the problem solved by the present invention nor a solution that is even remotely suggestive of the claimed solution. In fact, Dezonno et al. actually teach away from the present invention.

In addition to the points raised above, the Examiner has also failed to show WHERE in the cited references can be found a "clear suggestion" that the claimed combination is obvious. In *Gillette Co. v. S.C. Johnson & Son, Inc.*, 919 F.2d 720, 16 USPQ2d 1923 (Fed. Cir. 1990) the appellant argued that the district court misapplied the Section 103 nonobviousness standard "by adopting an overly stringent test" that required "that the claimed combination be "clearly suggested" by the prior art in order to be obvious." 16 USPQ2d at 1926.

The Federal Circuit found no reversible error stating:

"[In] *Kimberly-Clark [Corp. v. Johnson & Johnson]*, 745 F.2d 1437, 223 USPQ 603 (Fed. Cir. 1984) ], not only did we "fail to find a clear suggestion of the claimed subject matter," ... we found "not the slightest suggestion" in the art of the claimed dual function adhesive... .

As to whether "clear suggestion" is a proper test of obviousness, we note initially that *Kimberly-Clark* is not the only instance in which we have made use of that phrase in a discussion of obviousness. Various other formulations of the requisite level of suggestion for combining prior art disclosures have been set forth in our precedent.

We need not decide here whether "clear suggestion" is an overly rigorous test for obviousness, however... . [T]his court independently reviews obviousness determinations. In reaching our own conclusion regarding obviousness, we need not give deference to a particular analytical construct utilized in a district court's



opinion. Our task is to review the district court's judgment." 16 USPQ2d at 1926-27.

In *In re Oetiker* 24 USPQ2d 1443 (Fed. Cir. 1992), the court reiterated that "[t]here must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination" and "[t]hat knowledge can not come from the applicant's invention itself." 24 USPQ2d at 1446

Accordingly, since the Examiner has failed to state a *prima facie* case of obviousness of the pending claims and has failed to show a "clear suggestion" in the cited references itself for combining the art to render obvious Applicant's claimed combination, Applicant submits that the rejections of the pending claims are improper and should be withdrawn.

In view of the foregoing, Applicant respectfully submits that none of the cited references disclose or suggest all the elements recited in amended independent claims 1 and 10. Moreover, Applicant respectfully submits that there it is improper to combine the references because the Examiner has failed to provide any motivation to do so. Applicant submits that there is no motivation to combine any of the references since none of the references deal with, or even identify, the problem which the present invention is concerned. In fact, Applicant submits that

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several of the references teach away from the present invention because they disclose calling back the inquiring party at a specific time in the future designated by the inquiring party, whereas the present invention calls back immediately.

Accordingly, Applicant believes that all of the pending claims are in condition for allowance and requests early and favorable action on the merits. The Examiner is invited to telephone the undersigned, Applicant's Attorney of Record, to facilitate advancement of the present application.

Respectfully submitted,

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